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EXAMINER
SILVER, DAVID

ART UNIT	PAPER NUMBER
2128	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		10/608,021	BURNS ET AL.
		Examiner	Art Unit
		David Silver	2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 March 2003</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>sep 25 03</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1. Claims 1-32 are pending in Instant Application.

Information Disclosure Statement

2. The information disclosure statement(s) (IDS) submitted on Sept 25 2003 is/are in compliance with
the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement(s) is/are being
considered by the examiner.

Claim Interpretation

3. The mere ability, allowance, or enablement of a function does not necessitate the performance of
such function. Therefore, any prior-art not explicitly prohibiting the performance of a function has
the inherent ability, allowance, and enablement to perform such function. For example, claim 20
recites "wherein a parameter of the response allows access to a cache for access to the data", the
allowance does not necessitate the access. Therefore, any art not explicitly prohibiting such access
would have the inherent capability of allowance, ability, and enablement.

Claim Objections

4. Claim 32 is objected to for minor informality: appears "if" should rather state "of".

Drawings

5. The drawings (Figure 15c) are objected to under 37 CFR 1.83(a) because they fail to show compiled
JAVA logic as described in the specification **(para 39)**. The figure shows non-compiled JAVA code.
Any structural detail that is essential for a proper understanding of the disclosed invention should be
shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR
1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any
amended replacement drawing sheet should include all of the figures appearing on the immediate
prior version of the sheet, even if only one figure is being amended. The figure or figure number of
an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the
appropriate figure must be removed from the replacement sheet, and where necessary, the
remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to

show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 17-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory

subject matter.

As per claims 17-26, the Instant Claims are drawn to software, *per se*. The claims do not have hardware

elements. The claims are therefore not concrete, useful, and tangible.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 8, 15, 24, 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the **enablement requirement**. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention.

Claims 8, 15, and 24 do not enable one of ordinary skill in the art to make and use the invention because

they do not enable the compilation without undue experimentation.

Claims 31 and 32 do not enable one of ordinary skill in the art to make and use the invention without

undue experimentation because they do not enable representation of "instances".

8. Claims 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

    written description requirement. The claim(s) contains subject matter which was not described in

    the specification in such a way as to reasonably convey to one skilled in the relevant art that the

    inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 31 and 32, the Specification and the Claims fail to comply with the written description

requirement because they do not adequately disclose what an "instance" is, how it works, and how it is

represented.

9. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

    particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation "the components". There is insufficient antecedent basis for this limitation

in the claim. Specifically, the claims mention a method of testing logic components; however, no actual

components are invoked.

Claim 27 is ambiguous and therefore indefinite for using the term "logic-based". Specifically, what is a

"logic-based" component?

10. Claims not specifically mentioned are rejected by virtue of their dependency.

11. The Applicant is required to fix all other similar occurrences of the above-cited deficiencies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under
this section made in this Office action:
A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the
United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by
another filed in the United States before the invention by the applicant for patent, except that an international application
filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed
in the United States only if the international application designated the United States and was published under Article
21(2) of such treaty in the English language.

12. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Camut **(US 6,684,257)**.

As per claim 1, Camut discloses: A method of mechanizing a simulator for simulating a selected system

producing responses to requests comprising:

interactively creating a representation of at least one rule defining a response including a

representation of at least a portion of a request and a corresponding response of the selected system

(Fig 3 item 122-n);

providing a response engine compatible with the representation of the rule **(Fig 3 130-n)**; and

allowing access by the response engine to the representation of the at least one rule, whereby

receipt, at the response engine of a request forming part of the rule will generate the corresponding reply

(note Claim Interpretation above, col: 1 line: 64 to col: 2 line: 3).

As per claim 2, Camut discloses: The method of claim 1 wherein the response is dynamic **(Fig 2 item**

100 and text which further elaborates on the features of the item and figure).

As per claim 3, Camut discloses: The method of claim 2 wherein a parameter of the response allows

access to a file **(col: 2 line: 12-26)**.

As per claim 4, Camut discloses: The method of claim 2 wherein a parameter of the response allows

access to a cache **(col: 2 line: 12-26)**.

As per claim 5, Camut discloses: The method of claim 2 wherein a parameter of the response allows

access to a database **(col: 2 line: 12-26)**.

As per claim 6, Camut discloses: The method of claim 2 wherein a parameter of the response allows

access to the message **(col: 2 line: 12-26)**.

As per claim 7, Camut discloses: The method of claim 1 wherein the representation of the at least one

rule is metadata **(fig 1 item 100)**.

As per claim 8, Camut discloses: The method of claim 7 which further includes compiling the metadata

representing the at least one rule **(this is an inherent features. specifically, it is inherent that the**

representations, which are stored as metadata comprise at least one rule for the web server

response).

As per claim 12, Camut discloses: The method of claim 8 where interactively creating metadata is

implemented with a graphical user interface **(col: 1 line: 14-33)**.

As per claim 13, Camut discloses: The method of claim 8 which further includes storing the metadata

(col: 2 line: 38-42, col: 6 line: 43-50).

As per claim 14, Camut discloses: The method of claim 13 which further includes editing the metadata using the graphical user interface to produce edited metadata to alter the at least one rule and storing the edited metadata in the database **(col: 1 line: 14-33, col: 6 line: 43-50)**.

As per claim 15, Camut discloses: The method of claim 14 which further includes compiling the edited metadata to produce edited compiled logic and allowing access by the response engine to the edited compiled logic whereby a selected system producing responses produced by the altered rule may be simulated **(this is functionally equivalent to the program producing the request/response events and actions disclosed by the reference)**.

As per claim 16, Camut discloses: The method of claim 1 which includes storing more than one rule **(col: 6 line: 43-50)**.

As per claim(s) 17-26, note the rejection of claim(s) 1-9 and 14 above. The Instant Claim(s) is/are functionally equivalent to the above-rejected claim(s) and is/are therefore rejected under same prior-art teachings.

As per claim 27, Camut discloses: A method of testing logic based components comprising: mechanizing a simulation of one of the components, connecting the simulation to the other component; and directing a flow of information to the connected simulation and component for testing purposes **(these are all inherent features of the references. Specifically, the simulation is performed by the response/request system and the testing is performed by same system. The information flows through as it would through a "proxy" where one end believes it is connected to an actual "device" while it is being tested.)**.

As per claim 28, Camut discloses: The method of claim 27 wherein the flow of information is directed to the component and a flow of information from the component is directed to the simulation **(inherent feature)**.

As per claim 29, Camut discloses: The method of claim 27 wherein the flow of information is directed to the simulation and a flow of information from the simulation is directed to the component **(inherent**

feature).

As per claim(s) 30, note the rejection of claim(s) 1 above. The Instant Claim(s) is/are functionally

equivalent to the above-rejected claim(s) and is/are therefore rejected under same prior-art teachings.

As per claim 31, Camut discloses: The method of claim 30 wherein the request represents an instance in

a flow of information from the component **(the request is created at a point in time and therefore**

represents an instance).

As per claim 32, Camut discloses: The method of claim 30 wherein the reply represents an instance in a

flow if information to the component **(the reply is created at a point in time and therefore**

represents an instance).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented
> and the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),

that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are

summarized as follows:

> 1.   Determining the scope and contents of the prior art.
> 2.   Ascertaining the differences between the prior art and the claims at issue.
> 3.   Resolving the level of ordinary skill in the pertinent art.
> 4.   Considering objective evidence present in the application indicating obviousness or
>   nonobviousness.

13. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camut **(US 6,684,257)**

as applied to claim 1 above.

As per claim 9, the applied prior art does not expressly disclose that the metadata comprises interactively

using raw data.

At the time of the invention, it would have been an obvious matter of design choice to a person of

ordinary skill in the art to use such a data because Applicant has not disclosed that the particular feature provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with such feature because the choice of metadata composition on the particular problem to be solved would not affect the invention in the applied prior art. In any case, it is noted that data is comprised of various formats, including, RAW, text, binary, compressed, fixed format, etc. So, it would appear to be an obvious choice.

As per claim 10, Camut discloses all limitations of claim 8. Camut however does not disclose that the metadata comprises interactively using fixed format data. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use such a data because Applicant has not disclosed that the particular feature provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with such feature because the choice of metadata composition on the particular problem to be solved would not affect the invention in the applied prior art. In any case, it is noted that data is comprised of various formats, including, RAW, text, binary, compressed, fixed format, etc. So, it would appear to be an obvious choice.

As per claim 11, Camut discloses all limitations of claim 8. Camut however does not disclose that the metadata comprises interactively using XML data. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use such a data because Applicant has not disclosed that the particular feature provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with such feature because the choice of metadata composition on the particular problem to be solved would not affect the invention in the applied prior art. In any case, it is noted that data is comprised of various formats, including, RAW, text, binary, compressed, fixed format, etc. So, it would appear to be an obvious choice.

Examiner Requests

14. The Examiner respectfully requests, in the event the Applicants choose to amend or add new claims, that such **claims and their limitations be directly mapped to the specification, which provides support for the subject matter**. This will assist in expediting compact prosecution.

Conclusion

15. All claims are rejected.

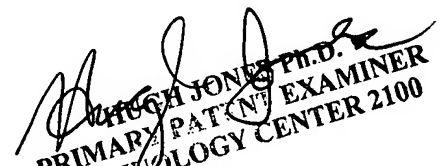16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Silver
Patent Examiner
Art Unit 2128

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